

## **REMARKS**

The Office Action mailed January 5, 2004 has been carefully considered. Claims 1, 5-6, 10-12, 17-18, and 22-28 are currently pending. Claims 1, 5-6, 10-12, and 17-18 have been amended to more clearly recite the claimed invention. Claims 22-28 are new.

Specifically, Claim 1 has been amended to more distinctly point out that at least one injury effector and at least one therapeutic-substance delivery effector are situated at different locations during the operation of the device on a patient. The amendments to claims 5-6, 10-12, and 17-18 are of a grammatical nature and have been made to more clearly recite the invention.

The amendments to claims 1, 5-6, 10-12, and 17-18, as well as new claims 22-28, are fully supported by the current specification, and therefore no new matter has been introduced. Reconsideration of the present application in view of the following remarks is respectfully requested.

### **Rejections under 35 U.S.C. § 102(b)**

Claims 1, 5, 6, 10-12, and 18 were rejected under 35 U.S.C. § 102(b) as being anticipated by United States Patent No. 5,536,267 to Edwards *et al.* ("Edwards"). This rejection is respectfully traversed.

Edwards discloses a device with multiple electrodes used in combination with a shaft and control structure. The electrodes may be of varying shape and size, but only one general embodiment of use is contemplated - that every electrode introduced in an array is a source of an infusing medium. Edwards clearly states that "after *the* electrodes are positioned around a mass, such as a tumor, a variety of solutions...can be introduced through *the* electrodes to the mass in a pre-ablation step." (*Id.* at 5:1-4) (emphasis added). Unlike the present invention, Edwards does not disclose an injury effector that produces an injury at one tissue site and the delivery of a therapeutic-substance to a second tissue site in which the first and second tissue sites are located in different locations in the tissue. Edwards also does not disclose the a device having at least one injury effector without drug delivery capabilities.

In fact, by teaching that its parts for infusing fluid into the treatment area are located on the electrode use to ablate the tumor, Edwards teaches away from the present invention which includes at least one injury effector for producing an injury at one location and a therapeutic-substance delivery effector with a port for delivery of a therapeutic substance for delivering a substance to a different location. Therefore, the rejections based on Edwards should be withdrawn.

**Rejections under 35 U.S.C. § 102(e)**

Claims 1, 5, 6, 10, 11, 17, and 18 were rejected under 35 U.S.C. § 102(e) as being anticipated by United States Patent No. 6,241,701 to Hofmann ("Hofmann"). This rejection is respectfully traversed.

Hofmann discloses a device used to treat tumors through electroporation therapy. Varying electroporation techniques and patterns are discussed. In one embodiment, therapeutic application of electroporation may be achieved by use of an array of electrodes having a needle configuration for insertion into tissue. However, there is no discussion or contemplation in Hofmann that the electrodes produce an injury but do not have drug delivery capabilities. Therefore, Hofmann does not teach, suggest, or disclose using at least one effector without drug delivery capabilities. Thus, the rejections based on Hofmann should be withdrawn.

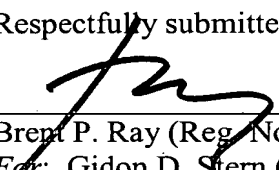
### CONCLUSION

In view of the above amendments and remarks, it is believed that claims 1, 5-6, 10-12, 17-18, and 22-28 are in condition for allowance. Should the Examiner not agree with Applicant's position, then a personal or telephonic interview is respectfully requested to discuss any remaining issues and expedite the eventual allowance of the application.

No fee is believed to be due for this response. Should any fees be required, please charge such fees to Jones Day deposit account no. 503013.

Respectfully submitted,

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